

REMARKS

In the July 15, 2003 Office Action, all of the pending claims 1-20 stand rejected in view of prior art. No other objections or rejections were made in the Office Action.

Status of Claims and Amendments

In response to the July 15, 2003 Office Action, Applicant has amended claims 2, 6 and 17-20 as indicated above. Applicant has also cancelled claim 16, without prejudice or disclaimer. Claim 2 was amended to more clearly define the present invention over the prior art of record. Claim 20 was amended to place it in independent form and to more clearly define the present invention over the prior art of record. Claim 6 was merely amended to place it in independent form. Finally, claims 17-19 were merely amended to change their dependencies. Thus, claims 1-15 and 17-20 are pending, with claims 1, 2, 6 and 20 being the only independent claims. Reexamination and reconsideration of the pending claims are respectfully requested in view of the above amendments and the following comments.

Interview Summary

Applicant's representative wishes to thank Primary Examiner Kim for the opportunity to discuss the above-identified patent application during the interview of October 10, 2003. In the Interview Summary, the Examiner stated that "Both parties agreed that Miller reference is non-analogous art that does not teach the sliding door following in an arcuate path along the outer surface of the housing." More specifically, both parties agreed that the Miller reference ***does not*** teach the "maintenance cover being configured to move along an arcuate path substantially parallel to said outer surface of said outer casing between said closed position and said open position", as set forth in independent claim 1. Also, regarding German Patent Publication No. 19922327, the July 15, 2003 Office Action specifically states that "the maintenance cover does not slideg an arcuate path substantially parallel to the outer surface of the outer casing between the open and closed postions". As such, Applicant believes that the combination of German Patent Publication No. 19922327 and the Miller reference ***fails*** to disclose or suggest the maintenance cover set forth in independent claim 1. Finally, the Examiner indicated during the interview that if Applicant will follow up with a Request for Reconsideration, the Examiner will provide another ***non-final rejection or pass the case to issue***.

Entry of March 20, 2003 Amendment

In the numbered paragraph 1 of the Office Action, the Office Action indicates that Applicant's March 20, 2003 Amendment has been entered. However, no mention was made in the Office Action as to whether Applicant's April 30, 2003 Supplemental Amendment was entered. Applicant notes that the March 20, 2003 Amendment includes 13 claims, while the April 30, 2003 Supplemental Amendment includes 20 claims. Since the Office Action Summary of the July 15, 2003 Office Action indicates that claims 1-20 are pending, Applicant's April 30, 2003 Supplemental Amendment is believed to have been entered.

Drawings

The numbered paragraph 2 of the Office Action indicates that the drawing received on March 20, 2003 has been approved. Also, the Office Action Summary indicates that the March 20, 2003 drawing is accepted by the Examiner. Applicant wishes to thank the Examiner for the approval and acceptance of this drawing.

Rejections - 35 U.S.C. §103

In the numbered paragraphs 3-4 of the Office Action, claims 1-20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over German Patent Publication No. 19922327 in view of U.S. Patent No. 4,885,219 (Miller). In response, Applicant respectfully traverses the rejection of independent claim 1, particularly in view of the following comments. Applicant also cancelled claim 16, without prejudice or disclaimer. Moreover, Applicant amended independent claim 2 to more clearly define the present invention over the prior art of record, and amended claim 20 to place it in independent form and to more clearly define the present invention over the prior art of record. In addition, Applicant amended claims 17-19 to depend from independent claim 20. Finally, Applicant amended claim 6 to place it in independent form.

More specifically, independent claim 1 clearly recites that the maintenance cover is configured to move along an arcuate path ***substantially parallel to the outer surface of the outer casing*** between the closed position and the open position.

Clearly, this arrangement is ***not*** disclosed or suggested by the combination of German Patent Publication No. 19922327 and the Miller patent, or any other prior art of record. With regard to German Patent Publication No. 19922327, the July 15, 2003 Office Action acknowledges that "the maintenance cover does not slide along an arcuate path substantially

parallel to the outer surface of the outer casing between the open and closed positions." See page 3 of the Office Action. Accordingly, the Office Action relies upon the Miller patent to show a maintenance cover configured to move along an arcuate path substantially parallel to an outer surface of an outer casing between a closed position and an open position.

The Miller patent *fails* to provide for the deficiencies of German Patent Publication No. 19922327. As mentioned above, during the interview both parties agreed that the Miller reference is *non-analogous art* that *does not* teach the maintenance cover as set forth in independent claim 1. In particular, the Miller patent *fails* to disclose any maintenance cover configured to move along an arcuate path *substantially parallel to an outer surface of an outer casing* between a closed position and an open position, as set forth in independent claim 1. Therefore, Applicant respectfully asserts that the combination of these two references *would not* produce a hypothetical device that would meet the claimed invention as set forth in independent claim 1.

It is well settled in U.S. patent law that the mere fact that the prior art can be modified *does not* make the modification obvious, unless the *prior art suggests* the desirability of the modification. Accordingly, the prior art lacks any suggestion or expectation of success for combining the references to create Applicant's unique arrangement of the maintenance cover and the outer casing as set forth in independent claim 1.

Therefore, Applicant respectfully requests that this rejection be withdrawn in view of the above comments and amendments.

Turning now to independent claim 2, this claim now recites a maintenance cover slidably coupled to the outer casing such that the maintenance cover *slides on an outer surface of the outer casing* between a fully closed position overlying the access opening in which the cable attachment point is non-accessible and a fully open position exposing the access opening such that the cable attachment point is accessible through the access opening in the fully open position.

Clearly, this arrangement is *not* disclosed or suggested by the combination of German Patent Publication No. 19922327 and the Miller patent, or any other prior art of record.

In particular, the German Patent Publication No. 19922327 *fails* to disclose any maintenance cover that is *slidably coupled* to an outer casing such that the maintenance cover *slides on an outer surface of the outer casing*, as now set forth in independent claim 2.

The Miller patent *fails* to provide for the deficiencies of German Patent Publication No. 19922327. As mentioned above, the parties agreed during the interview that the Miller patent is *non-analogous art*.

Moreover, the Miller patent discloses a battery storage compartment including a stationary housing and a door 200 with cylindrical shafts 210 and 230 that rotate on *surfaces* of support ribs located *inside the stationary housing*. In other words, the Miller patent *fails* to disclose that the door 200 is slidably coupled to the stationary housing such that the door 200 *slides on an outer surface of the stationary housing*, as now required by independent claim 2. Therefore, Applicant respectfully asserts that the combination of these two references *would not* produce a hypothetical device that would meet the claimed invention as now set forth in independent claim 2.

It is well settled in U.S. patent law that the mere fact that the prior art can be modified *does not* make the modification obvious, unless the *prior art suggests* the desirability of the modification. Accordingly, the prior art lacks any suggestion or expectation of success for combining the references to create Applicant's unique arrangement of the maintenance cover and the outer casing as now set forth in independent claim 2.

Turning now to independent claim 6, this claim recites an outer casing having a first complementary mounting structure, a cable receiving bore and an access opening, in which the outer casing includes a first casing half and a second casing half that are fixedly coupled together, *the access opening being partially formed in each of the first and second casing halves*.

Clearly this arrangement is *not* disclosed or suggested by the combination of German Patent Publication No. 19922327 and the Miller patent, or any other prior art of record.

While the German Patent Publication No. 19922327 shows a gear change switch having an upper housing part 2, a lower housing part and an opening, German Patent Publication No. 19922327 clearly shows that *the opening is only formed in the upper housing part 2*. In other words, the German Patent Publication No. 19922327 *fails* to disclose that *the opening is partially formed in each of the upper and lower housing parts*, as required by independent claim 6.

Moreover, the Miller patent *fails* to remedy the deficiencies of German Patent Publication No. 19922327. In particular, the Miller patent shows a stationary housing having

an upper housing member 300, a lower housing member 100, and an *opening* that is *only formed in the lower housing member 100*. In other words, the Miller patent *fails* to disclose that *the opening is partially formed in each of the upper and lower housing members 300 and 100*, as required by independent claim 6. Therefore, Applicant respectfully asserts that the combination of these two references *would not* produce a hypothetical device that would meet the claimed invention as set forth in independent claim 6.

It is well settled in U.S. patent law that the mere fact that the prior art can be modified *does not* make the modification obvious, unless the *prior art suggests* the desirability of the modification. Accordingly, the prior art lacks any suggestion or expectation of success for combining the references to create Applicant's unique arrangement of the outer casing and the access opening as set forth in independent claim 6.

Therefore, Applicant respectfully requests that this rejection be withdrawn in view of the above comments and amendments.

Turning now to independent claim 20, this claim now recites a bicycle shift control device including

- an outer casing having a cable receiving bore and an access opening, the outer casing including a first casing half and a second casing half that are fixedly coupled together, *each of the first and second casing halves including an outer surface with a rail coupled thereto*;
- a cable operated winding mechanism disposed in the outer casing;
- and
- a maintenance cover moveably coupled to the rails of the first and second casing halves* between a closed position overlying the access opening in which the cable attachment point is non-accessible and an open position exposing the access opening such that the cable attachment point is accessible through the access opening in the open position.

Clearly this arrangement is *not* disclosed or suggested by the combination of German Patent Publication No. 19922327 and the Miller patent, or any other prior art of record.

While German Patent Publication No. 19922327 shows a gear change switch with an upper housing part 2 and a lower housing part, German Patent Publication No. 19922327 *fails* to disclose that the upper and lower housing parts include *any rails* as set forth in independent claim 20 as now amended.

The Miller patent *fails* to remedy the deficiencies of German Patent Publication No. 19922327. While the Miller patent discloses a battery storage compartment with an upper housing member 300, a lower housing member 100 and a door 200, the Miller patent *fails* to disclose *any rails coupled to outer surfaces* of the upper and lower housing members 300 and 100, as required by independent claim 20 as now amended.

Moreover, the Miller patent *fails* to disclose that the door 200 is *movably coupled to any rails that are coupled to outer surfaces* of the upper and lower housing members 300 and 100, as required by independent claim 20 as now amended. Therefore, Applicant respectfully asserts that the combination of these two references *would not* produce a hypothetical device that would meet the claimed invention as now set forth in independent claim 20.

It is well settled in U.S. patent law that the mere fact that the prior art can be modified does *not* make the modification obvious, unless the *prior art suggests* the desirability of the modification. Accordingly, the prior art lacks any suggestion or expectation of success for combining the references to create Applicant's unique arrangement of the outer casing and the maintenance cover, as now set forth in independent claim 20.

Therefore, Applicant respectfully requests that this rejection be withdrawn in view of the above comments and amendments.

Moreover, Applicant believes that the dependent claims 3-5, 7-15 and 17-19 are also allowable over the prior art of record in that they depend from the independent claims 1, 2, 6 and 20, and therefore are allowable for the reasons stated above. Also, the dependent claims 3-5, 7-15 and 17-19 are further allowable because they include additional limitations. Thus, Applicant believes that since the prior art of record *does not* disclose or suggest the inventions as set forth in independent claims 1, 2, 6 and 20, the prior art of record also *fails* to disclose or suggest the inventions as set forth in the dependent claims.

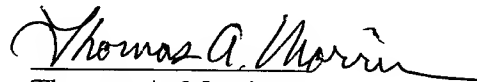
Therefore, Applicant respectfully requests that this rejection be withdrawn in view of the above comments and amendments.

Appl. No. 09/892,456
Amendment dated November 5, 2003
Reply to Office Action of July 15, 2003

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In view of the foregoing amendment and comments, Applicant respectfully asserts that claims 1-15 and 17-20 are now in condition for allowance. Reexamination and reconsideration of the pending claims are respectfully requested.

Respectfully submitted,


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